

## REMARKS

### *Summary of Changes Made*

Claims numbering as high as 12 have been in the application, and in previous amendments, claims 2, 4, and 9-12 were canceled. No changes to the claims are included herewith. Accordingly, claims 1, 3 and 5-8 (6 claims) remain pending in the application. No new matter is added by this amendment.

### *Claim Rejections - 35 U.S.C. §103(a)(Mellul)*

In the prior Office Action, the Examiner rejected claims 1, 3, and 5-8 under 35 U.S.C. 103(a) as obvious in view of Mellul, U.S. Pat. No. 5,612,021 ("Mellul"). The Examiner's reasoning for the rejections is identical to that in the previous two Office Actions.

Essentially, the Examiner contends that Mellul teaches a cosmetic composition that includes 0.1-50% wax, 0.5-15% of a resin and 0.5-30% of a hollow organic powder. The Examiner admits that Mellul fails to explicitly teach an example where the claimed ingredients and percentages are found in a single formulation. The Examiner does however contend that Mellul teaches all of the claimed components within the claimed percentage ranges.

Applicants do not dispute this latter contention, however even its correctness is insufficient to render the claims obvious, as Examiner left out a key point. The missing concept is that Mellul teaches the claimed components in ranges that overlap those instantly claimed **in different kinds of formulations**. The components and ranges cited by examiner are found in disclosure or examples involving different kinds of cosmetic formulations.

Indeed, the cited resin content (0.5-15%) at lines column 7, lines 1-3 of Mellul is taught for a *nail varnish*, and not a mascara (i.e., the claimed eyelash cosmetic). Indeed, the passage states "[t]he varnishes according to the invention can also contain a resin.... [b]etween 0.5 and 15% by weight relative to the total weight of the varnish." Mellul utterly fails to teach that a resin can be incorporated in a mascara formulation (or any other cosmetic formulation aside from a varnish). The only mention of a resin in Mellul is relative to its use in a nail varnish. Hence, on this basis alone, the *prima facie* case of obviousness of claims 1, 3, and 5-8 over Mellul fails.

The Examiner apparently presumes that all cosmetic formulations in Mellul are interchangeable as formulation ranges from a nail varnish and a lipstick are cited in the attempt to establish a *prima facie* case of obviousness for the claimed eyelash cosmetic (mascara)

formulation. Applicants assert that the skilled artisan would not use a nail varnish as a mascara or a lipstick as a nail varnish, for example. Such formulations are, of course, not interchangeable. Accordingly, the Examiner's citation of components and percentages thereof from different cosmetic formulations fails to establish a *prima facie* case of obviousness.

Not only does Mellul fail to disclose the claimed components and percentages in the same type of formulation, but the instant specification teaches that unexpected benefits are obtained by the narrowly claimed ranges and/or poor performance or unwanted behavior is obtained by including the claimed components in ranges outside those instantly claimed.

Examples of the latter phenomenon include paragraph 39 and Table 2 of the specification relative to the amount of wax, paragraph 41 and Table 3 relative to the amount of resin, and paragraphs 42-43 and table 4 relative to the amount of hollow powder.

In particular, instant Example 11 (Table 2) includes 35% of wax, and exhibited poor finishing. This is a teaching away from the upper portion of Mellul's wax range and an indication that satisfactory properties are achieved only by using the instantly claimed range of wax.

In Example 17 (Table 3), a mascara formulation with 30% of a resin exhibits poor finishing. This is a teaching away from the upper portion of Mellul's resin range and an indication that satisfactory properties are achieved only by using the instantly claimed range of resin.

In Example 22 (Table 4), a mascara formulation with 22% of a hollow powder exhibits poor volume effect, poor curling effect, poor curl retaining effect, and poor finishing. This is a teaching away from the upper portion of Mellul's resin range and an indication that satisfactory properties are achieved only by using the instantly claimed range of resin.

The foregoing examples show why component ranges outside those instantly claimed lead to detrimental effects, further establishing that the instantly claimed composition is both novel and non-obvious.

Mellul fails to disclose all of the limitations of claim 1, i.e., an eyelash cosmetic that includes all three of the elements presently claimed in claim 1 in the amounts recited in claim 1, with the limitation that the hollow particles be made out of resins having a true specific gravity (i.e., density) of 0.02 to 0.65. Mellul utterly fails to teach a mascara that includes a resin.

Although Applicants do not dispute that Mellul discloses the use of Expancel microspheres, Applicants again point out that the focus of Mellul is on the use of fullerenes in cosmetic compositions. Indeed, the title, abstract, broadest teachings, and every claim of Mellul teaches or recites the presence of a fullerene in a cosmetic composition. The Examiner attempts to restrict the citation of Mellul to the Expancel microspheres and ignores the pervasive teachings of fullerenes therein, in direct conflict with the law. Indeed, “[a] prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention.” *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). In focusing on the Expancel powders, which are disclosed as one of many in a long list of *optional* fillers (col. 3, line 38- col. 4, line 22) useful in an amount of 0.01 to 90% of the composition (a range so broad so as not to provide any meaningful direction and which does not lead to the instantly claimed range), and in ignoring the fact that none of the examples includes Expancel powders or anything similar, the Examiner has failed consider the art for what it teaches as a whole.

Clearly, the Examiner has failed to consider Mellul for what it teaches against the constructed obviousness rejection.

Based on the foregoing, claim 1 is not obvious in view of Mellul. Dependent claims 3, and 5-8 are patentable over Mellul for the same reasons.

## **CONCLUSION**

In light of the foregoing, Applicants respectfully request that the amendment be entered into the record and considered. Applicants respectfully submit that the present application, including claims 1, 3 and 5-8, is in condition for allowance and notice to that effect is hereby requested. If it is determined that the application is not in a condition for allowance, the Examiner is invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the present application.

If there are any additional fees resulting from this communication, please charge the same to our Deposit Account No. 18-0160, our Order No. IWI-16232.

Respectfully submitted,

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